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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,563	10/30/2002	Chi-Lei Kao	10053-US-PA	7632

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JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE
7 FLOOR-1, NO. 100
ROOSEVELT ROAD, SECTION 2
TAIPEI, 100
TAIWAN

EXAMINER

LEVI, DAMEON E

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
10/065,563	KAO, CHI-LEI	
Examiner	Art Unit	
Dameon E Levi	2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-35 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-35 and 40-43 is/are rejected.
- 7) ☒ Claim(s) 40-42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/30/2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

The claims are objected to because they include reference characters which are not enclosed within parentheses (see "A", "B" claims 40,42)

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25-35, 40-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Yao US Patent 6658516.

Regarding claim 25, Yao discloses a device comprising:

memory card comprising: at least one memory part, used to store information; at least one controller, used to control data communication, wherein the controller optionally is

integrated with the memory part; a plug, capable of being put back, used to connect to a connector of a USB series; and optionally a first I/O port, used to be externally connected to a second I/O port., wherein the memory card can select the first I/O port or the plug to connect to an electronic device for information communication, wherein the thickness of the memory card is less than 0.38cm (for example, see Figs 1-6, see columns 1-6).Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 26, Yao discloses comprising one selected from the group consisting of an IC card, a CF card, a SD card, a multimedia card, an XD picture . card, a memory stick card, a memory stick duo card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a USB silicon disk, (for example, see Figs 1-6, see columns 1-6)

Regarding claim 27, Yao discloses wherein the plug, the memory part, and the at least one controller can be separated from the memory card to form another independent memory card(for example, see Figs 1-6, see columns 1-6)

Regarding claim 28, Yao discloses a device comprising:
a memory part, used to store information; a controller, used to control information communication, optionally can be integrated with the memory part; a plug, capable of being put back, used to be connected to a connector; and optionally a first I/O port, used to be externally connected to a second I/O port; wherein the memory card can

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select the first I/O port to connect to the second I/O port of an electronic device, or select the plug to connect to a connector of an electronic device, so as to have information communication, wherein the memory card comprises one selected from the group consisting of an IC card, a CF card, a 5D card, a multimedia card, a XD picture card, a MG memory stick card, a memory stick duo card, a memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a U5B silicon disk(for example, see Figs 1-6, see columns 1-6). Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 29, Yao discloses comprising: a memory part, used to store information; at least one controller, used to control information transmission, and optionally being integrated with the memory part; at least two different I/O connectors, wherein one of the at least two I/O connectors includes a plug, which can be connected to a USB series A connector of the digital device, the plug comprises: a plurality of exposed metal connection terminals being exposed, used to electrically connect to corresponding metal connection terminals of the U5B series connector after the plug is connected to the USB connector, a thickness of the plug is less than 0.38 cm; and a non-metal holder, used to holed the metal connection terminals of the plug, wherein the holder can optionally include a metal frame rack, wherein the memory part comprises one selected from the group consisting of an IC card, a CF card, a SD card, a multimedia card, a XD picture card, a MG memory stick card, a memory stick duo card,

a memory stick card, a Microdrive card, a PCMCIA card, and a USB silicon disk(for example, see Figs 1-6, see columns 1-6)

Regarding claim 30, Yao discloses a device comprising:

at least two connectors, for connecting at least two different connectors installed on a single information storage device, which has been plugged therein; or capable of connecting to one connector installed on the single information storage device(for example, see Figs 1-6, see columns 1-6). Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison 69 USPQ 138

Regarding claim 31, Yao discloses wherein the single information storage device comprises one selected from the group consisting of an IC card, a CF card, a SD card, a XD picture card, a memory stick duo card, a memory stick card, a multimedia card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a USB silicon disk(for example, see Figs 1-6, see columns 1-6)

Regarding claim 32, Yao discloses wherein the single information storage device includes a master card associating with an independent card (for example, see Figs 1-6, see columns 1-6)

Regarding claim 33, Yao discloses a device comprising:

at least dual connector; and a slot, allowing a single information storage device to be plugged in, wherein the single information storage device includes at least two different connectors or at least one single connector, wherein the at least dual connector can be

connected to at least two different connector or the at least one connector on the single information storage device, which is plugged into the single slot(for example, see Figs 1-6, see columns 1-6)

Regarding claim 34, Yao discloses wherein the single information storage device comprises one selected from the group consisting of an IC card, a CF card, a SD card, a multimedia card, a XD picture card, a memory stick duo card, a MG memory stick card, a smart media card , a Microdrive card, a PCMCIA card, and a USB silicon disk(for example, see Figs 1-6, see columns 1-6)

Regarding claim 35, Yao discloses wherein the single information storage device includes a master card associating with an independent card.

Regarding claim 40, Yao discloses a device comprising:

at least one memory part, used to store information; at least one controller, used to control information communication, optionally being integrated with the memory part; at least one plug, which can be used to connected to a connector of a USB series for information communication with an electronic device ; and optionally comprising a first I/O part to connect to the second I/O of an electronic apparatus A; wherein a memory card B can be released from or retracted back to the memory card A, and the memory card A can provide the function of storing and accessing information on the memory card B, the memory card B can be . plugged into a card slot, wherein the memory card B includes one selected form the group consisting of an IC card, a CF card, a SD card, a multimedia card, a XD picture card, a memory stick card, a memory stick duo card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a

USB silicon disk, wherein the memory card A can select the first I/O port or the plug to connect to the second I/O port of the electronic apparatus A, so as to have information communication, wherein the memory card B optionally includes a controller and an I/O port for connecting with an external electronic apparatus B to control information transmission(for example, see Figs 1-6, see columns 1-6)

Regarding claim 41, Yao discloses wherein the memory card comprises one selected form the group consisting of an IC card, a CF card, a SD card, a multimedia card, a XD picture card, a memory stick card, a memory stick duo card, a MG memory stick card, a smart media card, a Microdrive card, a PCMCIA card, and a USB silicon disk (for example, see Figs 1-6, see columns 1-6)

Regarding claim 42, Yao discloses a device comprising:

a master card, having an I/O port, capable of connecting with a first external electronic device; a first controlling unit, implemented on the mater card, used to convert the I/O port into a USE interface; and a memory card, having a second control unit and a USE interface I/O port member, capable of connection with a second external electronic device, wherein the memory card can be mounted on the master card as a choice from a user, and by a mechanical operation or a direct connection, the USE interface I/O port member can be coupled with the USE interface, wherein only one at a time can be selected for information communication from the group consisting of case 1 that the USE interface I/O port member of the memory card is coupled with the USE interface and case 2 that the USE interface I/O port member of the memory card is coupled with the second external electronic device(for example see Figs 1-6, see columns 1-6)

Regarding claim 43, Yao discloses wherein when the memory card is mounted on the master card, the first control unit and the second control, unit can be optionally coupled together(for example, see Figs 1-6, see columns 1-6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E Levi whose telephone number is (703) 305-0426. The examiner can normally be reached on Mon.-Fri. (9:00 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David S Martin can be reached on (703) 308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0058.

Dameon E Levi
Examiner
Art Unit 2841

DEL

A handwritten signature in black ink, appearing to read 'Dl M', is positioned above the printed name of David Martin.

DAVID MARTIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800